

## **Remarks**

Claims 1, 3, 4, 13, 15-21, 25-35, 38-40, 45-46 and 51-52 are pending. Claim 7 is canceled in this Amendment.

All pending claims stand rejected under Section 103 as being obvious over Honda 20020191517 in view of Black 3426337 (and further in view of other references for some claims).

### **Establishing an Absolute Reference for Radial Positioning (Claims 13, 26, 39, 51)**

Claim 51 has been amended to recite that the reference pattern is positioned on a rim of the disk outside a label area in which images may be formed on the non-data side of the disk and establishing an absolute radial location as a reference for radial positioning over the label area on the non-data side of the disk. Similar amendments have been made to Claims 13, 26 and 39. Support for the amendments is found in Fig. 1 and paragraphs 0022 and 0034, for example, in Application serial no. 10/661,722 (Attorney Docket No. 200315232) incorporated by reference into the present application at paragraph 0001 of the Specification and in Fig. 3 and paragraph 0029 of Application serial no. 10/347,074 incorporated by reference into the present application at paragraph 0015 of the Specification.

The amendments to Claims 26, 39 and 51 are intended to clarify an "absolute" reference and more clearly distinguish the combination of Honda and Black. Amended Claim 51, for example, recites sensing a reference pattern that is positioned outside a label area and establishing an absolute radial location as a reference for radial positioning over the label area. Thus, the absolute radial location is established based on a pattern outside the label area as a reference for positioning inside the label area -- an open loop system.

Black teaches a closed loop system. As noted in the Response to the prior Action, in Black signal pulses derived from radial and spiral boundary transitions on the reference pattern are used to determine and control the position of the transducer over the disk. See, for example, Black column 2, line 71 through column 3, line 3. In Black, the configuration of the reference pattern allows the transducer to know where it is on the disk -- one side of the star shaped projections on the pattern are radii and the other is spiral -- the spoke narrows in the radial direction allowing the transducer to know how far out on the disk radially. The transducer must be over

the pattern to know where it is on the disk. Thus, Black's pattern extends out across nearly the full radius of the disk. Black Fig. 1.

The combination of Honda and Black, therefore, does not teach or suggest all of limitations of amended Claims 13, 26, 39 and 51 (or their respective dependent claims).

#### Speed Control Based On Sensing A Pattern Outside Label Area (All Claims)

Claim 1 has also been amended to recite that the pattern is positioned on a rim outside a label area in which images may be formed on the non-data side of the disk. (Support for the amendment to Claim 1 is the same as that noted above for the amendment to Claim 51.) Thus, in the amended claims rotational speed is controlled based on sensing a pattern outside the label area.

Black's reference pattern extends across nearly the entire disk. Black Fig. 1. Hence, even if it is assumed Black teaches speed control based on sensing this pattern, he does not teach speed control based on sensing a pattern outside the label area of Honda. See, for example, Honda label surface 52, Figs. 12A-12C.

The combination of Honda and Black, therefore, does not teach or suggest all of limitations of amended Claim 1 (or its dependent claims).

#### The Combination Renders Honda Inoperative (All Claims)

Honda is directed to a method for forming images on a label area of an optical disk by exposing the surface to a laser. Honda Abstract. Superimposing Black's reference pattern (which extends across nearly the entire disk) on Honda's disk would obliterate the label area, rendering the disk useless for its intended purpose. See, for example, Honda label surface 52, Figs. 12A-12C. Hence, there is no reason an ordinarily skilled artisan would combine Honda and Black even if it assumed the combination might somehow be interpreted as teaching the claimed subject matter. ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." MPEP 2143.01.V.)

#### Black Teaches Away From Open Loop Position Control (Claims 13, 26, 39, 51)

Black expressly teaches away from open loop position control. Black column 1, lines 35-68. In a closed loop position control system, the position of the moving part is continually detected (or, at least, it may be continually detected). In an open

loop system, by contrast, there is no sensor to continuously detect the position of the moving part. Black teaches a closed loop system. Establishing an absolute radial location based on a pattern outside the label area as a reference for positioning inside the label area reflects an open loop system.

A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. MPEP 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). The closed loop system of Black would not suggest an open loop system, as claimed, to the ordinarily skilled artisan particularly where, as here, Black expressly teaches away from the use of an open loop system.

For this additional reason, Claims 13, 26, 39 and 51 (and their respective dependent claims) distinguish over the combination of Honda and Black.

Respectfully submitted,

/Steven R. Ormiston/

Steven R. Ormiston  
Attorney for Applicant  
Registration No. 35,974  
208.433.1991 x204